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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/820,697 | 04/09/2004 | Takuya Hayasaka | 042326 | 8729 |

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EXAMINER

PURVIS, SUE A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1734

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,697

Applicant(s)

HAYASAKA ET AL.

Examiner

Sue A. Purvis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Funahashi (US Patent No. 3,812,782).

Regarding claim 1, Funahashi discloses a roller having a roller body (6), an elastic member (5) which is fitted to the outer circumference of the roller body (6), and the roller body having a fitted part for the elastic member. Figures 7 through 10 show embodiments with fitted parts used in conjunction with the elastic member. (Col. 3, lines 56-68; Col. 4, lines 1-15.)

Regarding claim 2, Funahashi discloses the elastic member being a doughnut shape. (See Figures 8 and 10.) The fitting part in Funahashi also has stepped portions as shown in Figure 9.

Regarding the limitation that the adherend has a doughnut shape, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). (See MPEP §2115.) Therefore, the shape of the adherend was not

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considered in determining the patentability of the claims. The roller disclosed in Funahashi is capable of being used with a doughnut shaped adherend, thus it meets the claim limitations.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Weihrauch (US Patent No. 5,779,610).

Regarding claim 1, Weihrauch discloses a roller having a roller body (11) and an elastic member (12) which is fitted to the outer circumference of the roller body (11) by means of a fitted part (20) for the elastic member. (See Figures 1 and 2; Col. 3, lines 39-67; Col. 4, lines 1-4.)

Response to Arguments

4. Applicant's arguments filed 27 December 2005 have been fully considered but they are not persuasive.

5. In response to the argument on page 3 that Funahashi does not include "said roller body having a fitting part for the elastic member on the outer circumferential surface" as recited in claim 1, Figures 7 and 9 in particular show a fitted part for the elastic members. Figure 7 shows the partitions (4'') which includes flanges (7) which fit the elastic member to the roller. Figure 9 shows a part (10) attached to the roller and comprising a disk (8) with an inner cylinder (9) and a part (13) with a disk (11) which hold the elastic member.

6. With regards to applicant's assertion that Funahashi does not disclose the "said elastic member being formed into a nearly doughnut shape corresponding to the plane shape of said information recording board" as set forth in claim 2, as set forth above this is shown in Figures 8 and 10. Applicant is reminded that during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

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Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Furthermore, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant recites on page 4 of their response that the "dough shape recited in claim 2 refers to the circumferential surface ("plan shape") of the roller. However, applicant does not claim this feature. The claim states the "elastic member being formed into a nearly doughnut shape" but does state the circumferential surface of the elastic member has a doughnut shape. That particular feature is shown in the specification as discussed by the applicant, but the claim does not recite that limitation.

7. Applicant asserts on page 4 of the response that Weihrauch does not disclose "an elastic member fitted on the out circumference of said roller body and contacts with a non-adhesive face of said label" as set forth in claim 1. Applicant asserts that the plush covering (12) is not elastic and that "[p]lush covering for applying paint is in the form of many small strands forming a brush." This is not a definition which is set forth in Weihrauch, so it is unclear where applicant gets this definition. Weihrauch discloses that "[a] known paint application roll has a uniform jacket or surface. The surface can be smooth, i.e. can be formed by a circular cylindrical carrying body with solid or slightly elastic plastic or rubber surface. However, it is also possible to form on the carrying body of the roll a resilient, paint-absorbing layer, particularly a plush, non woven, fleece or foam layer." (Col. 1, lines 53-59.) Nowhere does Weihrauch define a plush layer as set forth by the applicant and it is the position of the examiner that a plush layer is resilient as set forth by Weihrauch and is

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therefore "elastic" which is defined as "capable of recovering size and shape after deformation" in Merriam-Webster's Online Dictionary.

8. Applicant goes onto assert that the tubular sleeve in Weihrauch is not a fitting part, but fails to detail why it is not a fitting part as set forth in the claim. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
February 25, 2006